

REMARKS

In accordance with the foregoing, claims 7-10 are pending and under consideration. No new matter is presented in this Amendment.

REJECTIONS UNDER DOUBLE PATENTING:

Claims 7-10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,222,983 (the '983 patent). The Applicant respectfully traverses. The double patenting rejection is barred under 35 U.S.C. § 121. Even if the double patenting rejection is not barred by statute, the claims of the instant application are patentably distinct over the claims of the '983 patent.

Due to the somewhat complicated prosecution of these cases, a brief history of the relationship between the two applications is provided. The ultimate ancestor of the instant application and the '983 patent is Application Serial No. 08/928,082, filed August 29, 1997. A continuation-in-part application, Application Serial No. 09/047,363, was later filed claiming priority to the '082 application. The examiner in the '363 application issued a restriction requirement, which resulted in the filing of at least two divisional applications: Application Serial No. 09/526,275 and Application Serial No. 09/526,285. The '275 application matured into the '983 patent currently at issue. The '285 application was itself subject to a restriction requirement, which resulted in another divisional application, Application Serial No. 10/780,427, the instant application.

35 U.S.C. § 121 bars the use of a patent issuing on an application with respect to which a restriction requirement has been made, or on an application filed as a result of such a requirement, as a reference against a divisional application, if the divisional application was filed prior to the issuance of the patent. Here, the '285 application, from which the instant application derives, was filed before the issuance of the '983 patent and was a divisional application of the '363 application, as was the '983 patent. Thus, the '983 patent could not have been used in a double patenting rejection over the '285 application. The instant application, which is a divisional application of the '285 application, should receive a similar benefit, as the applicant had no opportunity, due to the restriction requirement issued in the '363 application, to include the subject matter of claims 7-10 in the application that matured into the '983 patent.

Even if the double patenting rejection is not barred under 35 U.S.C. § 121, the double patenting rejection should be withdrawn because the claims at issue and the claims of the '983 patent are patentably distinct. An obviousness-type double patenting rejection is proper only if the claims of the application and the claims of the patent are not patentably distinct. MPEP § 804(II)(B)(1). In contrast, a restriction requirement is proper only if the two inventions are patentably distinct. The '363 application was subject to a restriction requirement, which amounted to a determination that the '983 patent and the '285 application, both of which were divisionals of the '363 application, contained patentably distinct claims. The instant application is a divisional application of the '285 application, and thus contains distinct inventions within the same subject matter as the '285 application, which has already been determined to be patentably distinct from the '983 patent. Accordingly, the claims of the instant application are patentably distinct from the claims of the '983 patent, and the double patenting rejection should be withdrawn.

Further, the double patenting rejection would impose an undue burden upon the application, as the applicant could not have incorporated the subject matter at issue into the claims of the '983 patent, as such an amendment was barred by the prior restriction requirement.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

STEIN, MCEWEN & BUI, LLP

Date: _____

12/21/07

By: _____

Gregory L. Clinton

Registration No. 59,134

1400 Eye St., NW
Suite 300
Washington, D.C. 20005
Telephone: (202) 216-9505
Facsimile: (202) 216-9510